

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 45

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte KAORI KONDOH,
TETSUYA MASUISHI,
HIROSHI KOIKE,
RIE KOBAYASHI,
SATOSHI TAKEUCHI,
AKIRA MATOIKE,
and
JUN NITTA

Appeal No. 2003-0466
Application No. 08/871,964

HEARD: AUGUST 20, 2003

Before HAIRSTON, GROSS, and BLANKENSHIP, Administrative Patent Judges.

HAIRSTON, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the final rejection of claims
1 through 10 and 12 through 14.

The disclosed invention relates to a method, a system and a
storage medium for implementing a cyber mall.

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Claim 1 is illustrative of the claimed invention, and it reads as follows:

1. A cyber mall system for performing an agency selling of goods through a network, comprising:

a plurality of cyber shop clients which define cyber shop definition information including goods information including attributes of goods to be offered, layout information concerning a display layout of said goods, and cyber shop identifying information representing identification information of each cyber shop; and

a cyber mall server for receiving said cyber shop definition information from said cyber shop clients through said network, correlating said goods information, said layout information, and said cyber shop identifying information of said received cyber shop definition information for each cyber shop, storing the correlated information, and in response to an access request to one of said cyber shops from a customer client, generating a web page for displaying said layout information corresponding to cyber shop identification information of said requested cyber shop, by which web page a display of the offered goods is output to the customer client through said network.

The references relied on by the examiner are:

eShop Technology Overview, Internet address:
<<http://www.eshop.com/corp/technology.html>>, dated Jan. 1, 1996.

eShop In The News, Recent Press Releases, Internet address:
<<http://www.eshop.com/corp/press.html>>, dated Jan. 1, 1996, with press releases dated Nov. 7, 1995, Dec. 7, 1995 and Jan. 23, 1996 discussed therein.

Claims 1 through 10 and 12 through 14 stand rejected under 35 U.S.C. § 102(a) as being anticipated by the Internet version of eShop.

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Reference is made to the briefs (paper numbers 38 and 41) and the answer (paper number 39) for the respective positions of the appellants and the examiner.

OPINION

For all of the reasons expressed by the examiner, and for the additional reasons set forth infra, we will sustain the anticipation rejection of claims 1 through 10 and 12 through 14.

Appellants have challenged the propriety of using the Internet publications as evidence of activity under paragraph (a) of 35 U.S.C. § 102 that will preclude the patentability of the claimed invention (brief, pages 12 through 17). To be more specific, appellants argue that the January 1, 1996 date printed in the lower right hand corner on each sheet of the Internet documents conflicts with the January 23, 1996 press release date noted on page 1 of the eShop In The News publication. We agree with the examiner's position (answer, page 5) that:

The Appellant has [sic] made a valid point in stating that the references applied in the art rejection were not likely posted on the Internet exactly on January 1, 1996, due to the fact that one of the press releases cited is dated January 23, 1996. However, the Appellant's [sic] argument is moot since claims 1-10 and 12-14 stand rejected as being clearly anticipated by the "Internet version of eShop, the latest update of which was launched on November 7, 1995." The Examiner asserts that the cited references describe the Internet version of eShop as it existed on

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November 7, 1995. The Appellant has [sic] not presented any evidence to effectively counter this assertion. Furthermore, it should be emphasized that all of the cited press releases are dated at least several months prior to the Appellant's [sic] priority date of June 13, 1996. The press releases are dated as follows: 1/23/1996; 12/7/1995; 11/7/1995; 7/12/1995; and 2/1995. Therefore, the Examiner submits that the Internet version of eShop is indeed valid prior art.

The examiner's position is in keeping with In re Epstein, 32 F.3d 1559, 1565, 31 USPQ2d 1817, 1821 (Fed. Cir. 1994) which states that the Office can properly rely on the dates set forth in the Internet publications as proof that the disclosed and claimed invention was known or used by others in this country before appellants' patent application because of the "inapplicability of hearsay evidence rules in ex parte PTO examination"

Appellants' arguments (brief, pages 16 and 17) concerning a secret use of the eShop process is without merit in light of the extensive discussion of the same in the press releases. Thus, we disagree with appellants' conclusion that "an 'examination of the product' (use of eShop) would not have revealed the process so as to be a public use under §102(a)."

Appellants' argument (brief, page 19) that "the documents do not make clear that eShop actually established a mall system in which a plurality of shops are collected in a mall" is equally without merit in view of the use of the terms "online mall" or

"mall" in each of the press releases. In the absence of any evidence in the record that would serve to distinguish the eShop mall from the disclosed and claimed mall, we are of the opinion that the skilled artisan would know the characteristics of an "online mall" or a "mall" in the Internet world. In re Fox, 471 F.2d 1405, 1406-07, 176 USPQ 340, 341 (Fed. Cir. 1973).

With respect to appellants' argument (brief, page 19) that eShop neither teaches nor would have suggested a "cyber mall server, correlating said goods information, said layout information, and said cyber shop identifying information of said received cyber shop definition information for each cyber shop," we agree with the examiner (answer, page 7) that:

eShop provides a central cyber mall server, known as the eShop Plaza, which provides a shopping mall to Internet shoppers. This shopping mall incorporates the cyber stores of multiple merchants (i.e., cyber shop clients) who have signed up to take advantage of the eShop software (see at least pages 4-6 of "Recent Press Releases - eShop in the News"). In order to create such a cyber mall, eShop must inherently be "receiving" and "correlating" cyber shop information at the server side in order for eShop to maintain its "3D rendering of a shopping mall" (page 4 of "Recent Press Releases - eShop in the News"). Further, the recited claim language does not preclude the cyber mall server from receiving an entirely prepared cyber shop web site from the cyber shop clients. Therefore, art teaching a cyber mall server that merely serves as a web portal for links to various cyber shops would still meet the respective claim language.

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Appellants argue (brief, pages 20 and 21) that the server in eShop does not generate a web page as claimed. The examiner explains (answer, page 7) that:

[W]hen a web page is accessed via a browser, the HTML document associated with that web page is accessed as well. Then, any images referenced within the HTML tags are located and dynamically merged with the text information upon display to a user.

Appellants' disclosure makes clear that the web page is nothing more than the formation of an HTML source code (specification, pages 7, 27 and 34). Accordingly, we agree with the examiner's analysis (answer, pages 8 and 9) that:

As discussed above, all web pages are inherently created by a browser merging data corresponding to different tags with the basic HTML templates/layouts defined by the respective tags. All web pages accessed on the Internet are generated by a browser. Since eShop provides an eShop Plaza where various merchants are grouped together in a cyber shopping mall, eShop's cyber mall server inherently assists in generating the different cyber shops. The fact that the eShop cyber mall server displays web pages in response to a customer accessing a store in the cyber mall means that the eShop cyber mall server generates the requested web pages as well.

In view of the foregoing, the 35 U.S.C. § 102(a) rejection of claim 2 is sustained. The 35 U.S.C. § 102(a) rejection of claim 3 is likewise sustained because appellants have chosen to let this claim stand or fall with claim 2 (brief, page 10).

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Turning to claims 1 and 4, appellants' arguments (brief, pages 22 through 28) to the contrary notwithstanding, we agree with the examiner (answer, page 10) that "eShop teaches all of the recited functionality in the claims" as well as "the structural limitations recited in the claims" because "eShop is implemented through the World Wide Web, thereby incorporating World Wide Web browsers and World Wide Web servers, including a cyber mall server, various databases, and a cyber shop client (e.g., a merchant terminal)." Thus, the 35 U.S.C. § 102(a) rejection of claims 1 and 4 is sustained.

Turning lastly to appellants' arguments (brief, pages 28 through 30) concerning dependent claims 5 through 10 and 12 through 14, we agree with the examiner's analysis (answer, page 11) that the system features of these claims are either explicitly or inherently a part of the eShop system.

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DECISION

The decision of the examiner rejecting claims 1 through 10 and 12 through 14 under 35 U.S.C. § 102(a) is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED

KENNETH W. HAIRSTON
Administrative Patent Judge

ANITA PELLMAN GROSS
Administrative Patent Judge

HOWARD B. BLANKENSHIP
Administrative Patent Judge

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